

REMARKS

By this Amendment, 1-4, 6-8, 10, 16-20 are amended, claim 5 is canceled, and claim 21 is added. Thus, claims 1-4 and 6-21 are pending in this application. Applicants respectfully request reconsideration and prompt allowance of the pending claims at least in light of the following remarks.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiner Mancho in the April 4 personal interview. Applicants incorporate a separate record of the substance of the interview into the following remarks.

The Office Action objects to claim 18 for an informality. By this Amendment, claim 18 is amended to recite the "method" of claim 1, as suggested by the Office Action. Accordingly, Applicants request withdrawal of the objection.

Claims 1-20 are rejected under 35 U.S.C. §112, second paragraph, as indefinite. Applicants respectfully traverse the rejection.

With respect to the phrases "unnecessary for communication" and "instructing prior to initiating start-up of a navigation device," they are no longer included in the claims. Accordingly, the alleged indefiniteness of those elements is inconsistent with the pending claims.

With respect to the claimed elements reciting an "accessory signal," the phrase is clearly described in at least paragraphs [0006], [0027], [0036], [0070], [0073], [0082], [0091], [0105], and [0108], and Figs. 3 and 8, as a signal generated by, for example, accessory signal generation device 56, that may cause power to be supplied to electronic devices such as, for example, a navigation device within a vehicle. Accordingly, the term is definite.

With respect to the claimed elements reciting "portion" or "portions," the elements cannot be considered indefinite. First, Applicants note that the terms cannot be per se

indefinite, because at least 449 Patents have issued since 1976 claiming a "communication portion." Second with respect to Applicants' use of the terms in the claims, the terms are clearly defined and used in the art as "a section of a larger thing, or part of a whole." Thus, as used in the claims a portion may be considered a part of, for example, the navigation device (see Fig. 4). See also at least paragraphs [0026], [0047], [0057], [0061], and [0075], discussing the communication portion(s) in detail. Accordingly, the terms are definite.

Because, as discussed above the terms used within the claims are definite, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 7-17, 19, and 20 under 35 U.S.C. §102(e) over U.S. Patent No. 6, 907, 255 to Kawamoto. Applicants respectfully traverse the rejection.

Initially, because the Office Action does not reject claim 1 over Kawamoto and independent claims 7, 16, and 17 are claims reciting devices that either perform the method of claim 1 or store instructions for performing the method of claim 1, it is clear that the Office Action is not giving patentable weight to the claimed functions of the elements of claims 7, 16, and 17. In this respect, the Office Action appears to be relying on MPEP §2114 for the alleged proposition that any functional language in a device claim is not to be given patentable weight. The Office Action's reliance on MPEP §2114, is misplaced for at least the following reasons.

With respect to claim 7, claim 7 is drafted in a well accepted format for computer related inventions, in which the structure of a particular component of a computer, such a circuit or other hardware portion, is defined by the function it performs. That is, it is well established that the structure of a device may be defined by what it does, and in particular, functional clauses that define structural limitations cannot be disregarded. See *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1365 (Fed. Cir. 1999); *Pac-Tec Inc. v. Amerace Corp.*, 903

F.2d 796, 801 (Fed. Cir. 1990); *see also Application of Barnhart*, 417 F.2d 1395 (CCPA 1969) and *Application of Bradley* 600 F.2d 807 (CCPA 1979).

Although MPEP §2114 appears to state that functional limitations in device claims are not to be given patentable weight, §2114 only applies in situations in which the claimed functional limitations are inherent to the structure of the applied prior art. See MPEP §2114, *citing In re Schriber*, 128 F.3d 1473, 1477-1478 (Fed. Cir. 1997). However, in the context of computer related inventions, a circuit, software, or other electronic component does not inherently perform a function unless it has been specifically designed or programmed to so. *Id.* (recognizing that the functions of both software and firmware/circuits carry patentable weight)¹. *See also High Tech Med. Instrumentation, Inc. v. New Image Indus.*, 49 F.3d 1551, 1555 ("a device does not [anticipate] simply because it is possible to alter it in a way that would satisfy the limitations of a patent claim").

Therefore, because Kawamoto fails to describe the functions of claim 7, Kawamoto also fails to describe structure capable of performing those functions. Claim 7 is thus patentable over Kawamoto for the same reasons that claim 1 is patentable over Kawamoto.

With respect to claim 16, claim 16 is drafted in means-plus-function format as defined in 35 U.S.C. §112, sixth paragraph. For a claim element to be considered drafted in means-plus-function, it must recite only functions without sufficient structure to perform the function. Accordingly, MPEP §2114 does not apply to means-plus-function limitations, and cannot be relied on to ignore the functional limitations of claim 16.

¹ Applicants also note that if the functions of a program, circuit, or other hardware portion of a computer related device or apparatus did not carry patentable weight, as alleged by the Office Action, there could be no patented computer related apparatus or devices because the first computer, circuit, or other hardware component, invented would anticipate all subsequent computers, circuits, or other hardware components.

Therefore, because Kawamoto fails to describe the functions of claim 16, Kawamoto also fails to describe structure capable of performing those functions. Claim 16 is thus patentable over Kawamoto for the same reasons that claim 1 is patentable over Kawamoto.

With respect to claim 17, claim 17 is drafted in a well-accepted format of a "program claim" (see the PTO's *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, which recognizes that "functional descriptive material" carries patentable weight when embodied in "some computer-readable medium"). According to this well accepted format, a storage medium stores instructions for performing a method, the instructions being executable by a data processing device. It is also well accepted that the "structure" of the storage medium is described by the function the instructions perform. See *Barnhart*, 417 F.2d 1395 and *Bradley* 600 F.2d 807. Accordingly, MPEP §2114 does not apply to such program claims in which the "structure" of the storage medium is defined by the function of the instructions stored thereon, and cannot be relied on to ignore the alleged functional limitations of claim 17.

Therefore, because Kawamoto fails to describe the functions performed by the instructions recited in claim 17, Kawamoto also fails to describe a storage medium storing such instructions. Claim 17 is thus patentable over Kawamoto for the same reasons that claim 1 is patentable over Kawamoto.

In view of at least the foregoing claims 7, 16, and 17 are patentable for at least the reasons that claim 1 is patentable. Further, claims 8-15, 19, and 20 are patentable for at least the reasons that claims 7, 16, and 17 are patentable, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-4 and 6-21.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Amendment Transmittal w/ check # 178903 (\$200)
Petition for Extension of Time w/ check # 178900 (\$120)
Request for Continued Examination w/ check # 178899 (\$790)

Date: April 14, 2006

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